



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,473	02/06/2001	Ervin F. Johnston		8971
7590 01/21/2009				
ERVIN F. JOHNSTON 3829 SNEAD DRIVE SIERRA VISTA, AZ 85650				
EXAMINER				
KARMIS, STEFANOS				
ART UNIT		PAPER NUMBER		
3693				
MAIL DATE		DELIVERY MODE		
01/21/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/777,473

Applicant(s)

JOHNSTON, ERVIN F.

Examiner

STEFANOS KARMIS

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 20 February 2008.

Status of Claims

2. Claims 1-83 are cancelled. Claims 84-115 are currently amended. Claims 84-115 are currently under prosecution in this application.

Response to Arguments

3. Applicant's amendment to the claims has also caused new grounds of rejection under 35 U.S.C. 112.
4. Applicant's arguments with respect to claims 84-115 have been considered but are not persuasive as discussed below.
5. Regarding claims 87-89, 95-97, 103-105 and 111-113, the Examiner first notes that the preamble has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. In response to applicant's argument that the prior art fails to teach "enabling a simultaneous display of said plurality of unsorted transactions having fields filled with transaction data...". A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant's use of "enabling" is not functional. Therefore Applicant is reminded that, given the broadest reasonable interpretation, the prior art systems only be "enabled" to simultaneously display said plurality of unsorted transactions. The Examiner suggests amending the claim to provide functionality (ex: simultaneously displaying a plurality of unsorted transactions on the debtor's computer screen..." and "inserting a plurality of the category items..."). This adds functionality to the claim rather than reciting intended use.
7. The amended language has been addressed below in the rejection under 35 U.S.C. 103.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 87-89, 95-97, 103-105 and 111-113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- Claims 87-89, 95-97, 103-105 and 111-113 are rejected under 35 U.S.C. 112, second paragraph because the phrase "unsorted transactions" renders the claim indefinite. There is no

discussion of unsorted transactions in Applicant's specification. Instead, Figure 3, appears to be sorted based on Invoice No., Date of Purchase, Send/Inv Date. Therefore, it appears Applicant is not going from unsorted to sorted, but rather from one sorting to another sorting. Further the user can insert category tags to sort based on user defined categories. Therefore it is unclear whether criteria such as Invoice No. and Date of Purchase are considered sorting criteria or whether sorting criteria are the categories only, such as "Ash St." For Examination purposes the claims are interpreted as claiming sorting of transactions from one label/category to another. Since Applicant's specification fails to teach "unsorted transactions" and the transactions listed in Figure 4 appear to be sorted as discussed above.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 84-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiasson U.S. Publication 2002/0002513 in view of Kitchen et al. (hereinafter Kitchen) U.S. Patent 6,289,322.

Regarding claims 84, 92, 100 and 108, Chiasson teaches a method for an internet hosted bill paying system:

Chiasson teaches upon one or more commands by the debtor, enabling the debtor to insert a plurality of category items selected by the debtor in selected open fields associated with the transactions and display respective selected fields filled with selected category items on the debtor's computer screen (page 11, paragraphs 107-109); and upon one or more commands by the debtor enabling the debtor to sort the transactions by one or more category items selected by the debtor and display the transactions sorted by said one or more category items on the debtor's computer screen (page 12, paragraph 0111 and paragraph 0114). Chiasson fails to show a debtor's computer and a debtor's computer screen that is responsive to the debtor's computer, at least one creditor that has a creditor's computer as well as the graphical representation.

Kitchen teaches enabling a simultaneous display of said plurality of unsorted transactions on the debtor's computer screen with each unsorted transaction of at least some of the unsorted transactions having fields filled with transaction data which are pertinent to the unsorted transaction and having at least one open field open for insertion of a category item pertinent to the unsorted transaction (Fig. 8 and Fig 9C; column 12, lines 55-65 and column 14, lines 33-45; Examiner notes that the bills listed in Fig 9C enables a simultaneous display of unsorted bills and that they contain the "status" field, which allows for inserting categories such as "unpaid". This "unpaid" can then be used to categorize/sort the bills).

Kitchen teaches electronic bill processing between a debtor's computer and a creditor computer (Figures 1 and 2). Kitchen also teaches the a graphical representation with buttons for adding categories and viewing or sorting by the categories (Figure 8, 14 and 9A and column 13, line 1 thru 25 and column 13, line 48 thru column 14, line 15). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the

category teachings of Chiasson to include the graphical representation and computer network teachings of Kitchen because it allows for the visual representation of bills when paying bills over a computer network.

Claims 85, 93, 101, 109, Chiasson teaches further comprising the step of: enabling a display of said plurality of category items as category item buttons on the debtor's computer screen so that the debtor can activate selected category item buttons for displaying said selected category items in said selected open fields on the debtor's computer screen (page 11, paragraph 109). Kitchen also teaches enabling a display of said plurality of category items as category item buttons on the debtor's computer screen so that the debtor can activate selected category item buttons for displaying said selected category items in said selected open fields on the debtor's computer screen (Figure 8 and 9A and column 13, line 1 thru 25 and column 13, line 48 thru column 14, line 15).

Claims 86, 94, 102 and 110, Chiasson fails to teach the graphical representation of rows on the computer screen. Kitchen teaches the steps of enabling a display of rows of line items on the debtor's computer screen with each line item representing a transaction and having transaction data columns and a category item column wherein the transaction column has fields filled with said transaction data and said the category item column has an open field; upon the debtor activating a selected line item and then activating a selected category item button,

enabling a display of the open field for the selected line item filled with the category item associated with the selected category item button (Figure 9C).

Regarding claims 87-89, 95-97, 103-105 and 111-113, Chiasson in view of Kitchen teaches the use of categories for labeling bills and viewing bills.

Claims 90, 98, 106 and 114, Chiasson teaches that bills are for products or services purchases. Chiasson fails to show the graphical representation. Kitchen teaches displaying at least some of the sorted transactions on the debtor's computer screen which includes at least product or services purchased, amount paid for the product or services and date paid transaction data (Figure 9B and Figure 11 and Figure 13).

Claims 91, 99, 107 and 115, Chiasson in view of Kitchen teach approving the bill paying. Chiasson in view of Kitchen fail to teach enabling the display of an account balance in a monetary funding account with the monetary funding activity on the debtor's computer screen. Official Notice is taken that viewing account balances before paying bills is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Chiasson in view of Kitchen to allow for viewing the account balance before paying the bills because it allows a check to see if there is sufficient funds to cover the bill amount.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
16 January 2009